

REMARKS

Applicant has studied the Office Action dated August 24, 2005. It is submitted that the application, as amended, is in condition for allowance. Claims 1-15 and 17 remain pending. Claims 1-3, 5-12, 14-15, and 17 are amended. Reconsideration and allowance of the pending claims in view of the following remarks is respectfully requested.

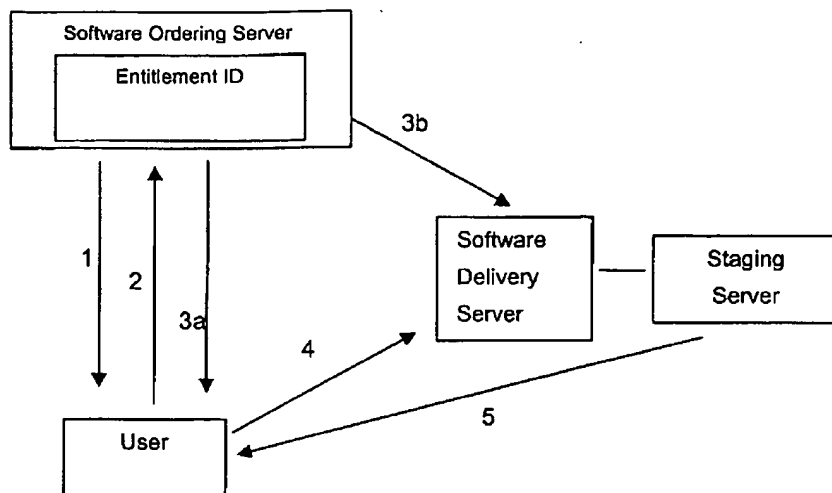
In the Office Action, the Examiner:

- (5-6) rejected claims 1, 3-12, 14, 15, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Eberhard et al. (U.S. Patent Application No. 2001/0011238) in view of Fawcett (U.S. Patent No. 5,845,077); and
- (7) rejected claims 2 and 13 under 35 U.S.C. § 103(a) as being unpatentable over as being unpatentable over Eberhard et al. (U.S. Patent Application No. 2001/0011238) in view of Fawcett (U.S. Patent No. 5,845,077) and further in view of Klemba et al. (U.S. Patent Pub. No. 2002/0128975 A1).

Overview of the Present Invention

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. The following figure and brief description is intended to further clarify the features of the present invention.

The present invention, shown below, is a method, computer readable medium, and system for the central management, delivery, and installation of media-less software.



In step 1, a user is presented, by a software ordering server, with a list of software available on the software ordering server. See page 13, first para., FIG. 7, and claim 1 of the instant application. In step 2, the user communicates to the software ordering server, an order for at least one software file from the list of available software. See page 9, second para., FIG. 3, and claim 1 of the instant application. In the third step, which is a two-part step and is shown as 3a and 3b in the figure above, the software ordering server communicates a response to the user (3a) that the user's request for software has been received. *Ibid.* The response contains an entitlement ID, that is an encrypted code that is later used by the user to obtain the software file from a server other than the software ordering server. In the second part of the third step (3b), the software ordering server also sends the same entitlement ID to a software delivery server. *Ibid.* In the fourth step, the user requests from the software delivery server a copy of the selected software file by communicating the entitlement ID along with the request for software delivery to the software delivery server. *Ibid.* In the fifth and last step, the software delivery server compares the entitlement ID received from the user to the entitlement ID received from the software ordering server in step 3b and sends instructions to a scheduling server to schedule the forwarding of a copy of the requested software from a staging server, which holds the software files, to the user in response to the two entitlement IDs matching.

Independent claims 1, 9, 11, 12, 15, and 17 are completely consistent with the above

figure and description and read, in part, as follows. Step numbers have been added to the claims to help map the claim steps to the figure above. Claims 9, 11, 15, and 17 are from the perspective of the software delivery server and, thus, begin at step 3b.

Claim 1:

...
presenting to a user a list of software for installation on a client system; [1]
receiving a user selection for ordering at least one software file from the list of software on a software ordering server; [2]
receiving a response to the order for at least one software file from the software ordering server, the response includes an entitlement ID for authorizing the installation of the software file, wherein the entitlement ID is sent from the software ordering server to the client system and the software delivery server; [3a and 3b]
requesting a download copy of the at least one software file from the software delivery server, the request includes the entitlement ID previously received from the software ordering server; [4]
receiving, in response to the entitlement ID received from the software ordering server matching the entitlement ID received with a request for the download copy, the copy of the at least one software file from a staging server as part of a payload containing at least one customized installation script; and
installing the received copy of the at least one software file. [5]
(indicator numbers added)

Claim 9:

...
receiving from a software ordering server, an entitlement ID for authorizing the installation of at least one software file which has been previously ordered on a client system, wherein the software ordering server originates the entitlement ID; [3b]
receiving a request from the client system for the download of a copy of the at least one software file to the client system, wherein the request includes an entitlement ID used to order the software file; [4]
verifying both the client system's PC compatibility for the requested copy of at least one software file and that the entitlement ID received from the ordering server matches the entitlement ID used to order the at least one software file; and
scheduling the download of the requested software from a

staging server to the client system. [5]
(indicator numbers added)

Claim 11:

...
receiving an order entitlement ID for at least one software file, which has been previously ordered from a client system on a software ordering server, wherein the software ordering server originates the entitlement ID; [3b]
storing the entitlement ID for at least one software file in a database;
receiving a request for the down-load of at least one requested software file with a download entitlement ID from a client system; [4]
determining if the download entitlement ID matches the order entitlement ID previously stored in the database, and in response to the order entitlement ID matching the download entitlement ID , scheduling a response to the request for a copy of the at least one software file at a scheduling server. [5]
(indicator numbers added)

Claim 12:

...
presenting to a user a list of software for installation on a client system; [1]
receiving a user selection for ordering at least one software file from the list of software on a software ordering server; [2]
receiving a response to the order for at least one software file from the software ordering server, the response includes an entitlement ID for authorizing the installation of the software file, wherein the entitlement ID is sent from the software ordering server to the client system and the software delivery server; [3a & 3b]
requesting a download copy of the at least one software file from the software delivery server, the request includes the entitlement ID previously received from the software ordering server; [4]
receiving, in response to the entitlement ID received from the software ordering server matching the entitlement ID received with a request for the download copy, the copy of the at least one software file from a staging server as part of a payload containing at least one customized installation script; and [5]
installing the received copy of the at least one software file.
(indicator numbers added)

Claim 15:

...
receiving an entitlement ID for at least one software file,
which has been previously ordered from a client system on a
software ordering server, wherein the software ordering server
originates the entitlement ID; [3b]
storing the entitlement ID for at least one software file in a
database;
receiving a request for the down-load of at least one
requested software file with a download entitlement ID from a
client system; and [4]
determining if the download entitlement ID matches the
order entitlement ID previously stored in the database, and in
response to the order entitlement ID matching the download
entitlement ID, scheduling a response to the request for a copy of
the at least one software file at a scheduling server. [5]
(indicator numbers added)

Claim 17:

...
a network interface for coupling at least one client system;
an order entitlement ID received over the network interface
for at least one software file, which has been previously ordered
by the at least one client system on a software ordering server;
[3b]
a database used to store the entitlement ID for at least one
software file;
a download request received over the network interface from
at least one of the one or more client systems for a copy of the at
least one software file, wherein the request includes an order
entitlement ID for at least one software file, wherein the software
ordering server originates the entitlement ID; and [4]
means for determining if the entitlement ID received from the
client system matches the order entitlement ID previously stored
in the database, and in response to the order entitlement ID
received from the client system matching the previously stored
entitlement ID, scheduling a response to the request for a copy of
the at least one software file at a scheduling server. [5]
(indicator numbers added)

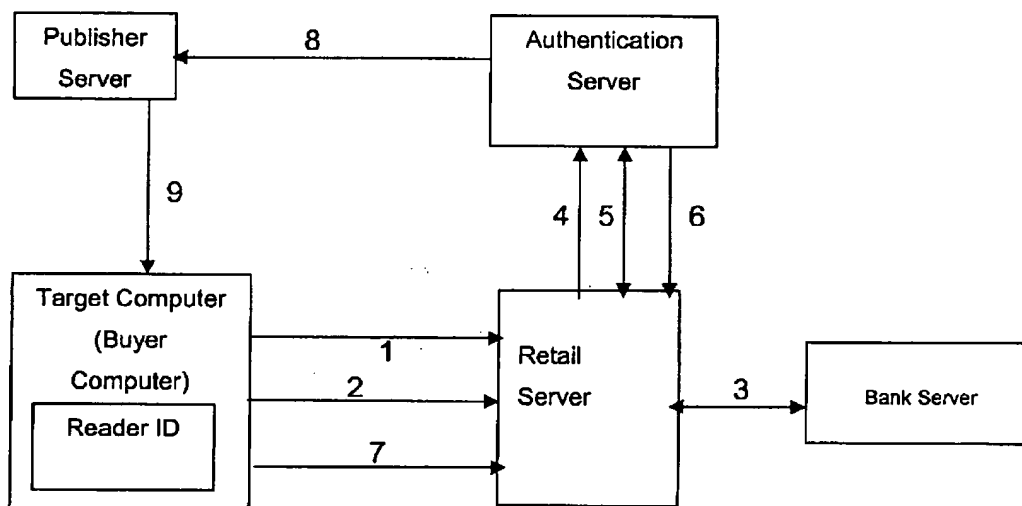
(5-7) Rejection under 35 U.S.C. §103(a) Eberhard et al. in view of Fawcett

As noted above, the Examiner rejected claims 1, 3-12, 14, 15, and 17 under 35 U.S.C.
§ 103(a) as being unpatentable over Eberhard et al. (U.S. Patent Application No.

2001/0011238) in view of Fawcett (U.S. Patent No. 5,845,077).

The Eberhard reference discloses a secure content delivery system directed towards network distribution of electronic books. The system of Eberhard includes 1.) a reader installed on the target workstation (device), 2.) a retail server, 3.) an authentication server, and 4.) a publisher server.

The following figure graphically shows what is disclosed in the flow diagram in FIG. 2A of Eberhard, as well as the corresponding sections of the disclosure. It is submitted that the following figure shows how the Eberhard system is different to the present invention.



In step 1, the target computer connects to a retail Web site such as amazon.com. See Eberhard at paragraph 0029. In step 2, the user of the target computer selects one or more titles sends a purchase request. See *Id.* "The purchase request is typically a unique identifier such as an ISBN number and is accompanied by customer and/or reader identification information and payment authorization". In step 3, "the retail server seeks authorization to charge the customer's account for the amount of the retail purchase". See Eberhard at paragraph 0030. In step 4, the "retailer server sends a fulfillment request to the authentication server". See *Id.* In step 5, "the authentication server obtains the user's reader ID from the retailer server as part of the fulfillment

request". See Id. The "authentication server checks the hash and decrypts the ID, after which the ID is compared to the reader ID database maintained on the authentication server". See Id.

In step 6, the "authentication server sends back to the retailer server a fulfillment confirmation, which causes the retailer server to complete the capture of payment from the user's credit card or other account". See Eberhard at paragraph 0031. In step 7, the user requests a download and the authentication server generates a build request. See Eberhard at paragraph 0034. In step 8, "the Build request (or, in some embodiments, authorization) is sent to the appropriate publisher server". The "publisher server encrypts the requested file with the reader's public key or ID". See Id. In step 9, "the publisher server forwards the now-encrypted file to the user PC". See Id. The "user connects the reader to the PC, which permits the title to be downloaded to the reader". See Eberhard at paragraph 0035.

As claimed in the present invention, the software is delivered by the software delivery server and **not by the vendor computer**, as is done in Eberhard. A key feature in Eberhard is that the publication (i.e. the payload) only resides at the publisher server. The payload gets delivered to the target workstation, but in a form that can only be viewed by an authorized reader. See Eberhard at paragraph 0028, wherein Eberhard teaches: "In an important feature, the distribution scheme of the present invention never requires that the content...be licensed to any intermediate holder; that is neither the retailer server nor the authentication server need have any control over or custody of the content, which passes solely between the publisher server 100 and the user OC 110." In this way, Eberhard actually teaches away from the present invention. A model where the vendor (i.e. publisher server) delivers the requested item to target workstations does not work well in an enterprise software delivery application that needs to perform standard delivery of software to hundreds of thousands of customer workstations located around the world. The present invention allows for the presence of hundreds of software "staging servers" located around the world which will efficiently perform the installation. Prior art that teaches away is per se demonstration of lack of

prima facie obviousness. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Furthermore, as claimed in the present invention, the entitlement ID is originated by the software ordering server and is sent to both the client system and the software delivery server. Eberhard teaches that the client system already contains a reader ID before the electronic content is ordered. The client system originates the reader ID and the client system sends the reader ID to the retail server. In other words, the client system does not receive an entitlement ID from a software ordering server.

Clearly, Eberhard does not show "receiving a response to the order for at least one software file **from the software ordering server...wherein the entitlement ID is sent from the software ordering server to the client system and the software delivery server**" or "receiving...the copy of the at least one software file **from a staging server** as part of a payload containing at least one customized installation script" as recited in amended claim 1 of the instant application. Independent claims 9, 11, 15, and 17 recite limitations similar to independent claim 1. Therefore, the independent claims 1, 9, 11, 15, and 17 of the present invention distinguishes over Eberhard for at least these reasons.

The Examiner correctly states on page 3 of the present Office Action that Eberhard "does not explicitly disclose that the product is software, nor does Eberhard disclose the installation of the software product after receiving the software product, nor the inclusion of an installation script." However, the Examiner goes on to combine Eberhard with Fawcett stating that Fawcett "discloses in an analogous client/server user-selection update system the ability to enable a user to view and purchase software for installation and to automatically install the application independently of the user ("a user selection of desired software..." in col. 11 lines 60-61.¹ Further, "downloading the desired software to the first computer and installing the desired software on the first computer..." in col. 12 lines 42-44. The installation is performed automatically, as

¹ Applicants make no statement whether such combination is even proper.

shown in col. 10 lines 49-54.) It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the distribution system of Eberhard to allow software distribution and installation as described by Fawcett, as this allow a user to purchase and install software easily via the Internet, further allowing publisher to maintain custody of their exclusive content and ensure protection of the publisher's rights, as noted in paragraph 0009 and 0010 of Eberhard."

The Fawcett reference describes Microsoft's Windows Update Function. The function clearly works well for delivering "Microsoft software" products, patches, etc. to Windows clients. However, Fawcett, like Eberhard does not teach or suggest the limitations of "receiving a response to the order for at least one software file **from the software ordering server...wherein the entitlement ID is sent from the software ordering server to the client system and the software delivery server**" and for "receiving...the copy of the at least one software file **from a staging server** as part of a payload containing at least one customized installation script" as claimed in the present invention.

When there is no suggestion or teaching in the prior art for "receiving a response to the order for at least one software file **from the software ordering server...wherein the entitlement ID is sent from the software ordering server to the client system and the software delivery server**" and for "receiving...the copy of the at least one software file **from a staging server** as part of a payload containing at least one customized installation script" the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Payne taken alone and/or in view of Fawcett does not even suggest, teach or mention the client/server network of the present invention. Accordingly, independent claims 1, 9, 11, 12, 15, and

17 distinguish over Eberhard taken alone and/or in view of Fawcett for this reason as well.

Independent claims 1, 9, 11, 12, 15, and 17 have been amended to distinguish over Eberhard taken alone and/or in view of Fawcett. Claims 3-8, 10, and 14 depend from claims 1, 9, and 12 respectively, since dependent claims contain all the limitations of the independent claims, claims 3-8, 10, and 14 distinguish over Eberhard taken alone and/or in view of Fawcett as well.

(7) Rejection under 35 U.S.C. §103(a) Eberhard et al. in view of
Fawcett and further in view of Klemba

As noted above, the Examiner rejected claims 2 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Eberhard et al. (U.S. Patent Application No. 2001/0011238) in view of Fawcett (U.S. Patent No. 5,845,077), and further in view of Klemba (U.S. Patent Publication 2002/0128975).

For reasons stated above in the section entitled "Rejection under 35 U.S.C. §103(a) Eberhard in view of Fawcett", Eberhard taken alone taken alone and/or in view of Fawcett are silent on "receiving a response to the order for at least one software file from the software ordering server...wherein the entitlement ID is sent from the software ordering server to the client system and the software delivery server" and for "receiving...the copy of the at least one software file from a staging server as part of a payload containing at least one customized installation script."

The Examiner correctly states on page 9 of the present Office Action that "*Eberhard nor Fawcett explicitly disclose receiving a request for acceptance of a software license agreement, and setting the acceptance to the software delivery server.*" However, the Examiner goes on to combine Eberhard and Fawcett with Klemba stating that "*Klemba discloses in an analogous client/server software distribution system the act of requesting acceptance of a software license agreement, and sending the acceptance to the software delivery server as claimed ('upon agreement of the EULA...' in paragraph*

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0037).² *It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the license ability of Klemba with the software distribution system of Eberhard, modified by Fawcett, as this would enable a vendor to impose legal standards on the to-be-installed software in the system of Eberhard, modified by Fawcett."*

When there is no suggestion or teaching in the prior art for "receiving a response to the order for at least one software file **from the software ordering server...**wherein the entitlement ID is **sent from the software ordering server to the client system and the software delivery server**" and for "receiving...the copy of the at least one software file **from a staging server** as part of a payload containing at least one customized installation script" the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Payne taken alone and/or in view of Fawcett does not even suggest, teach or mention the client/server network of the present invention. Accordingly, independent claims 1 and 12 distinguish over Eberhard taken alone and/or in view of Fawcett and/or in view of Klemba for this reason as well.

Claims 2 and 13 depend from independent claims 1 and 12, respectively. Since dependent claims contain all of the limitations of the independent claims from which they depend, it is accordingly believed to be clear that Payne et al., whether taken alone or in any combination with Fawcett and/or Klemba, neither shows nor suggests the features of claims 2 or 13. Claims 2 and 13 are, therefore, believed to be patentable over the art.

² Applicants make no statement whether such combination is even proper.

CONCLUSION

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.


Applicant acknowledges the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicant respectfully submits that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

Date: November 25, 2005

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